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TRADEMARK TRIAL
AND APPEAL BOARD

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No. 378,948, published in the Official Gazette on December 20, 1983 at TM 323

UNIVERSAL CITY STUDIOS, INC., Opposer, -against- NINTENDO OF AMERICA, INC., Applicant.	Opposition No. 68799 NOTICE OF OPPOSITION

UNIVERSAL CITY STUDIOS, INC. (herein "Opposer"), a Delaware corporation having its principal place of business at 100 Universal City Plaza, Universal City, California, believes that it will be damaged by the registration of the designation DONKEY KONG JUNIOR for "Video Output Game Machines and Parts Therefor" shown in Application Serial No. 378,948, and hereby opposes the same.

As grounds of opposition, it is alleged that:

1. Opposer, through its "Universal Pictures" division is engaged generally in the business of producing and

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distributing motion pictures for theatrical and other types of exhibition in the United States and throughout the world. Through its corporate affiliate, Merchandising Corporation of America, Inc. (herein "Merchandising"), Opposer is also engaged generally in the business of licensing the use of various Universal trademarks, service marks, symbols, trade names and characters owned by Opposer for the use by others in connection with the sale of articles of merchandise and services.

2. By virtue of certain agreements and written assignments entered into between Opposer and RKO General, Inc. and Opposer and the heirs of Merian C. Cooper, Opposer is the owner of all trade names, trademark, service mark and other rights in the name, character and story of KING KONG, created and developed by Merian C. Cooper prior to 1933 and produced and released as motion picture under the name "KING KONG" by RKO Radio Pictures Inc. in 1933, and subsequently as a remake motion picture under that name by Dino DeLaurentiis Corporation in 1976.

3. During the 1960's, RKO -- Opposer's predecessor in interest -- licensed the production of other motion pictures featuring the character KING KONG, one entitled "KING KONG VERSUS GODZILLA" a second entitled "KING KONG ESCAPES" and an animated television series entitled "THE KING KONG SHOW."

4. The name KING KONG denotes a gigantic gorilla and the story of King Kong, as made popular by the story of Merian C. Cooper and motion pictures of RKO and Dino DeLaurentiis -- to whose rights in KING KONG Universal has succeeded -- tells of the gorilla's discovery by an American movie crew on an island in the South Pacific, his subsequent capture and transport to New York and the gorilla's attachment for the female star of the film. Among the most popular and famous scenes of the "KING KONG" motion pictures produced by RKO and Dino DeLaurentiis is King Kong at the top of a large building holding the female lead of the film captive while attempting to repel the efforts of others to rescue her.

5. Both the RKO 1933 and Dino DeLaurentiis 1976 "KING KONG" motion pictures were extensively advertised and promoted throughout the United States and both are currently offered for sale and rental to the public in the form of video cassettes. Both motion pictures have acheived and enjoyed enormous nationwide popularity and commercial success, the 1933 RKO "KING KONG" having been continuously exploited by RKO and its licensees for the past 50 years and the 1976 remake "KING KONG" having been continuously exploited by RKO licensees for the past 8 years, through theatrical and television exhibition.

6. At least as early as 1933, and long prior to July 6, 1981, the date of first use claimed by applicant, Opposer

and its predecessor in interest have commercially developed and exploited the KING KONG name in motion pictures and have continuously used in interstate commerce the name KING KONG, the character KING KONG and elements of the KING KONG story in association with the other motion pictures and television shows as previously described and in the advertising and sale of consumer products and services, including various toys, posters and sundry items.

7. As a result of the extraordinary popularity and commercial success of the original 1933 "KING KONG" motion picture, the KING KONG motion pictures of the 1960's, the "KING KONG" remake motion picture of 1976 and the KING KONG television shows and consumer products licensed by RKO Pictures and RKO, and the extensive advertising and promotion undertaken in connection therewith, the KING KONG name, character and story, including the visual image of a giant gorilla atop a tall building, have become, and are, well known to the public, and are associated and identified by the public with their creators to whose rights therein Opposer has succeeded, is now owner and has expanded upon as described infra.

8. As a result of the foregoing activities, the name KING KONG, the gorilla character KING KONG and visual image of KING KONG atop a large building have become, and are, well known to the public in connection with motion pictures,

television shows and consumer products and services, including especially products and services in the entertainment fields, all of which the public identifies as deriving from a single origin and source.

9. Opposer has expanded on the promotions and commercial efforts of its predecessors with respect to KING KONG by licensing the KING KONG name and KING KONG character to Tiger Electronics, Inc., for use by the latter in the manufacture and sale of a home video game and cassette which feature the KING KONG name and character of the gorilla KING KONG, by licensing the KING KONG name and KING KONG character to National Electronics & Watch Co., Ltd., for use by the latter in the manufacture and sale of wrist game watch which will feature the KING KONG name and character of the gorilla KING KONG, and by authorizing Robert Keith & Co. to display a KING KONG balloon on top of the Empire State Building in conjunction with the 50th anniversary celebration of the 1933 RKO movie.

10. Opposer is the owner of the trademark "KING KONG" registered in the United States Patent and Trademark Office under No. 1,076,514, on November 1, 1977 for "Toy Animal Figures and Playsets." This trademark registration was duly assigned by the Mego Corporation, the original owner of the trademark, to RKO General, Inc., Opposer's predecessor in interest. RKO General, Inc. duly assigned the trademark to Opposer on January 3, 1983.

11. The aforesaid registration is valid and subsisting, unrevoked and uncancelled. Opposer is the owner of the trademark and the registration and all the business and goodwill connected therewith in the United States. Pursuant to Rule 2.122(d)(2) of the Trademark Rules of Practice, Opposer will make this registration part of the record by filing a notice of reliance on the registration, accompanied by a status and title copy of the registration, during Opposer's testimony period.

12. By the application herein opposed, the applicant seeks to register the designation DONKEY KONG JUNIOR for "Video Output Game Machines and Parts Therefor."

13. The goods to which applicant's mark is applied are closely related to the goods and services using the KING KONG trademark owned by Opposer and move through the same channels of trade as Opposer's goods.

14. Applicant's said mark DONKEY KONG JUNIOR so nearly resembles the KING KONG name and trademark KING KONG as to be likely, when applied to applicant's goods, to cause confusion, to cause mistake and to deceive, with consequent injury to Opposer, to the trade and to the public.

15. Opposer will be damaged by the registration sought by applicant because such registration will assist and

support applicant in the confusing and misleading use of the mark sought to be registered and will create statutory rights in the applicant in violation and derogation of the prior rights of Opposer.

WHEREFORE, Opposer believes that it will be damaged by the registration of applicant's mark and prays that the application for registration be denied.

TOWNLEY & UPDIKE

Dated: January 18, 1984

BY: Mary D. Faucher
Attorney for Opposer
405 Lexington Avenue
New York, N.Y., 10174

OF COUNSEL:

Douglas C. Fairhurst, Esq.
Mary D. Faucher, Esq.
Sandra Edelman, Esq.

I hereby certify that this Notice of Opposition is being deposited with the United States Postal Service as first class mail in an evelope addressed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

on January 18, 1984.

Sandra Edelman

Sandra Edelman, Esq.

January 18, 1984
Date